REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

a. Claim objections

The informalities identified in claims 8 and 9 in the Office action have been corrected according to the suggestions provided in the action. Removal of the objections to claims 8 and 9 is respectfully requested.

b. Claim amendments

Claim 1 is amended in the manner as claim 1 is presented in the allowed, corresponding European patent EP 1,208,539 B1 which was, by way of interest, maintained after an opposition proceeding. Particularly, claim 1 recites both a reference data detection phase and a verification phase. The steps described in the method are classified in one of these two phases. Support for this amendment is clearly found in the specification beginning on page 2, line 26 through page 3, line 17.

Claims 10 and 13 are amended to recite the apparatus as a "chip card." Support for this amendment is found on page 2, lines 27 and 28. Claim 12 is amended in view of the amendment to claim 10. It is submitted that no new matter has been added to the application, and entry of the amendment to these claims is respectfully requested.

c. New Claims

New claim 19 recites the subject matter of claims 1 and 2 combined with the subject matter of claim 3. New claim 20 recites the subject matter of claims 1 and 4 combined with the subject matter of claim 5.

Entry of the new independent claims is respectfully requested.

2. Information disclosure statement

a. Acknowledgment of information disclosure statement filed on May 26, 2004

In reference to the information disclosure statement filed on May 26, 2004, the applicants have not received an initialed copy of the Form PTO-1449 indicating consideration of the references submitted with such information disclosure statement. If the examiner needs a copy of any one of the references cited on the Form PTO-1449 included with the information disclosure statement, applicants invite the examiner to contact the undersigned attorney listed below.

Applicants respectfully request acknowledgment of the references cited in the information disclosure statement in the next Office communication.

b. New information disclosure statement

An information disclosure statement is submitted herewith wherein prior art documents that were cited in an European opposition proceeding in corresponding European patent EP 1,208,539 B1 are provided.

3. Rejection of claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,719,950 (Olsen et al.) in view of U.S. patent 6,081,750 (Hoffberg et al.)

This rejection is respectfully traversed on the basis that the proposed combination of the Olsen et al. and Hoffberg et al. patents, whether considered collectively or individually, fail to disclose or teach the subject matter of the claims of the pending application. As a result, the proposed combination fails to render the pending claims *prima facie* obvious.

The shortcomings of the Osten et al. patent are clearly addressed in the appeal brief that was originally filed on July 19, 2004. Moreover, it is acknowledged in the outstanding Office action that the Osten et al. patent fails to teach detecting properties that influence the sensory detection of biometric data, and which are stored in a second memory storage and taken into account during a verification stage, as

required by the pending claims. According to the action, the Hoffberg et al. patent is used to overcome these shortcomings.

Turning to the teachings of the Hoffberg et al. patent, it is submitted that this patent fails to teach detecting properties that influence the sensory detection of biometric data which are stored in a second memory storage and taken into account during a verification stage. Instead, the Hoffberg et al. patent teaches that the acquisition of the individual factors serve to predict the desires of the person to be carried out by connected systems.

The Hoffberg et al. patent describes an interface for a programmable system including, for example, a video recorder, a medical device, a vehicle control system and the like. This system is adapted to select a function desired by a user. To achieve this purpose, the system uses recorded user history (abstract).

Contrary to the assertion in the action, the Hoffberg et al. patent does not discuss that upon acquisition and analysis of the biometric features, the individual factors of the person may be additionally considered which influence the acquisition of the biometrical data. The passage of column 49, lines 56-65, of the Hoffberg et al. patent, which is relied upon in the action, merely describes that the system may identify relevant users by means of biometrical features. There is simply no mention of detecting properties that influence the sensory detection of biometric data, and which are stored in a second memory storage and taken into account during a verification stage.

The Office action also cites the passage of column 34, lines 18 - 34, in support of the notion that the Hoffberg et al. patent teaches the missing subject matter of the Osten et al. While this passages of the Hoffberg patent describe the acquisition of certain individual factors of a user, it does not teach or suggest to use these individual factors for influencing the creation or processing of biometrical data. Instead, this passage clearly points out that, depending on the acquired individual properties, it is possible to conclude that the user is in a certain mood and that this knowledge on the user's mood may assist in finding out certain desires of the user towards the behavior

of the controlled system, such as climate conditioning as described in column 33, line 63 through column 34, line 17.

In view of these observations, it is readily evident that the Hoffberg et al. patent describes that biometrical data may be analyzed for identifying a user and that it is also possible to acquire individual factors of a person. According to the Hoffberg et al. patent, however, these factors are not used to influence the identification of a person in whatsoever manner. Instead, the Hoffberg et al. patent simply suggests that the acquisition of the individual factors serves to predict the desires of the person to be carried out by the connected system.

It is readily evident that there is no source among the Olsen et al. and Hoffberg et al. patents, neither in the nature of the problem solved by these respective patents nor in their specific teachings, that provide a teaching, suggestion or motivation to combine the references in a manner prescribed in the action to implement or execute each and every feature of the methods, systems and chip cards according to the pending claims. Simply put, both the Olsen et al. and Hoffberg et al. patents fail to teach detecting properties that influence the sensory detection of biometric data, and which are stored in a second memory storage and taken into account during a verification stage.

While it is not disputed that both the Olsen et al. and Hoffberg et al. patents teach obtaining biometric data from a user, there is not substantial evidence in the action to extrapolate the teaching from these references that the mere acquisition of certain individual factors are necessarily used to verify obtained biometric data. Thus, it cannot be said that there is such relevant evidence as a reasonable mind might accept as adequate to support the conclusion that one of the Olsen et al. and Hoffberg et al. patents teach both a reference data detection phase and a verification phase of the manner required by the pending claims. It cannot be said that there is such relevant evidence as a reasonable mind might accept as adequate to support implicitly the conclusion that a skilled artisan confronted with (1) the problem noted in applicants' disclosure, i.e., verifying detected biometric reference data, and (2) the

statements in the Olsen et al. and Hoffberg et al. patents, would have been motivated to devise the entirety of the subject matter required by the pending claims.

Accordingly, it is submitted that the proposed combination of the Olsen et al. and Hoffberg et al. patents fails to teach each and every feature required by the pending claims, and therefore do not render the pending claims as *prima facie* obvious. Withdrawal of this rejection is kindly requested.

4. Conclusion

In view of the amendments of the claims and the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that claims 1-10 and 12-20 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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